

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID KELLERMAN

Appeal No. 97-0132
Application 08/157,709¹

ON BRIEF

Before MEISTER, STAAB and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the final rejection of claims 1, 3 through 7 and 10 through 18. The appellant has since canceled

¹ Application for patent filed November 24, 1993. According to appellant, this application is a continuation-in-part of Application 07/957,984, filed October 6, 1992, now abandoned, which is a continuation-in-part of Application 07/690,661, filed April 24, 1991, now U.S. Patent No. 5,154,682, issued October 13, 1992, which is a continuation-in-part of Application 07/407,145, filed September 14, 1989, now abandoned.

claims 10 and 18 and amended claims 1 and 17. Thus, the appeal now involves claims 1, 3 through 7 and 11 through 17, all of the claims presently pending in the application.

The invention relates to a shoe insert designed for use as an adjustable orthotic device. Claim 1 is illustrative and reads as follows:

1. A shoe insert for placement on an inside surface of a shoe comprising in combination:

a shoe insole formed of a non-compressible sheet of deformable synthetic organic thermoplastic resin having a thickness of at least 10 mils up to 50 mils and being shaped to fit over said inside surface of a shoe, said sheet having memory to permanently retain a deformed shape and said sheet having a continuous, smooth, seamless upper surface and having a bottom surface; and

the bottom surface of said sheet including a layer of first fastening material selected from loop fabric or hook fabric and a plurality of cushion pad elements, each containing a layer of resilient compressible, cushioning material and each having a top surface including a layer of second fastening material releasably engageable with said first fastening material selected from loop fabric or hook fabric, said elements being attached to said layer of first fastening material and at least one of said elements containing a thicker layer of cushioning material whereby when the insert is placed on the inside surface of a shoe, said elements compress under the weight of the user, the sheet deforms in the space between the elements and at locations where adjacent pad elements differ in thickness and retains a deformed shape

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when the force from the user's weight is removed to selectively modify the elevation or pitch of said insert relative to said inside surface of said shoe.²

The items relied upon by the examiner as evidence of obviousness are:

Meyer	4,756,096	Jul. 12, 1988
Shaffer et al. (Shaffer)	4,841,648	Jun. 27, 1989
Sarkozi	5,138,774	Aug. 18, 1992
		(filed May 13, 1991) ³
Andresen et al.	313163	Mar. 3, 1983
German Document (Andresen) ⁴		

² The recitation in claim 1 of the bottom surface of the sheet as "including" a layer of first fastening material is inconsistent with the underlying specification and with dependent claims 6 and 7 which indicate that the layer of first fastening material covers, but is not included in, the bottom surface of the sheet. This discrepancy is deserving of correction in the event of further prosecution before the examiner.

³ Although the instant application purportedly is a continuation-in-part of Application 07/690,661, filed April 24, 1991, and of Application 07/407,145, filed September 14, 1989 (see note 1, supra), the appellant has not asserted that the subject matter on appeal is entitled to the benefit of these earlier filing dates under 35 U.S.C. § 120. We therefore presume that the Sarkozi patent is prior art with respect to the subject matter on appeal even though its filing date is subsequent to the filing dates of the appellant's earlier applications.

⁴ An English language translation of this reference, prepared on behalf of the Patent and Trademark Office, is appended hereto.

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The items relied upon by the appellant as evidence of non-obviousness are:

The 37 CFR § 1.132 declarations filed on October 24, 1994 and on April 7, 1995, respectively (Paper Nos. 6 and 11).

Claims 1, 3 through 7 and 11 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Meyer in view of Andresen, Sarkozi and Shaffer.⁵

Having carefully considered the scope of the claims, the teachings of the applied references and the respective viewpoints advanced in the appellant's main and reply briefs (Paper Nos. 18 and 20) and in the examiner's answer (Paper No. 19), we shall not sustain this rejection.

Claims 1 and 17, the two independent claims on appeal, recite a shoe insert comprising, inter alia, a shoe insole formed of a non-compressible sheet of deformable synthetic organic thermoplastic resin having memory to permanently retain a deformed shape, and a plurality of cushion pad elements attached to the bottom of the sheet. These claims also require that when the insert or insole is placed in a shoe, the sheet deforms under

⁵ The final rejection (Paper No. 8) contained a number of additional rejections, all of which have been withdrawn by the examiner in light of the papers filed on April 7, 1995 (Paper Nos. 10 and 12). See the advisory letter dated May 18, 1995 (Paper No. 13).

the weight of the user in the space between the cushion pad elements and retains a deformed shape when the user's weight is removed to selectively modify the elevation or pitch of said insert relative to the inside surface of the shoe.

Although each of the applied references discloses a shoe insert having an element which corresponds generally to the sheet set forth in claims 1 and 17, none of these prior art sheet-like elements appears to have the deformation and memory characteristics required by these claims. In this regard, the Meyer blank 16 is a multi-layer compilation made of a semi-rigid, bendable, resilient thermoplastic resinous sheet material 24 and a resilient, compressible foam layer 26. The Andresen insert 1 is made of a soft elastic material such as foam rubber. The Sarkozi lining element 10 is a laminate made of fabric layers 11 and 12 and elastic layers 13 and 14. The Shaffer insole pad 12 is made of a resilient material.

The examiner's attempts to explain away the foregoing differences between the claimed shoe insert and the teachings of the prior art are not well taken. To begin with, the examiner contends that because the claim limitations defining the deformation and memory characteristics of the sheet are set forth in functional language, they cannot serve to distinguish the

claimed subject matter over the prior art (see page 5 in the answer). This position, however, runs counter to the well established principle that there is nothing intrinsically wrong with defining something in a claim by what it does rather than by what it is. See In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971). The examiner alternatively urges that given the appellant's disclosure that the sheet defined in the claims may be made of a vinyl resin (specification, page 7), the polyvinylchloride embodiment of Meyer's blank 16 (see Meyer at column 5, line 66 through column 6, line 11) would meet the sheet deformation and memory characteristics set forth in the claims (see pages 7 and 8 in the answer). This argument, however, is inconsistent with Meyer's disclosure that the blank 16 is a semi-rigid and resilient element. It simply does not follow from the fact that the appellant's sheet and Meyer's blank may be made from the same basic resin that these elements will have the same deformation and memory characteristics.

Thus, the combined teachings of Meyer, Andresen, Sarkozi and Shaffer do not disclose and would not have suggested a shoe insert having a sheet of the sort recited in independent claims 1 and 17. Hence, these references fail to establish a prima facie

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case of obviousness with respect to the subject matter recited in the claims on appeal. This being the case, it is not necessary to evaluate the merits of the appellant's evidence of non-obviousness.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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